

REMARKS

The Applicant respectfully requests reconsideration of the Application in view of the foregoing amendments and the following remarks. The Applicant originally presented Claims 1-34 for consideration in this Application. The Applicant confirms the provisional election, with traverse, to prosecute the invention of Claims 1-28, as previously elected in a teleconference with the Examiner on March 26, 1998. Claims 1-28 stand rejected. Claims 29-34 have been cancelled. Accordingly, Claims 1-28 are presented for prosecution.

REJECTIONS UNDER 35 U.S.C. §112, second ¶

The Examiner has rejected Claims 1, 4, 8, 10, 13, 17, 21, 24-25, 27-28, and those dependent therefrom, under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner has taken exception with certain claim language and identified certain cases of a lack of proper antecedent basis. The forgoing amendments have been made solely to comply and correct deficiencies in form identified by the Examiner and by Applicant after further consideration. The Applicant believes the Claims to now comply with the requirements of 35 U.S.C. §112, second ¶, and requests that the Examiner withdraw the rejection thereof.

REJECTIONS UNDER 35 U.S.C. §102(e)

Applicant respectfully traverse's the rejection of Claims 1-2, 9, and 12-13, under 35 U.S.C. 102(e), as being anticipated by Tong. Whereas Claims 2, 9 and 12-13 are dependent from Claim 1 and, thus, cannot be anticipated if Claim 1 is anticipated, the Examiner's rejection will be addressed with respect to Claim 1.

The invention, as defined in Claim 1 as originally-presented and as amended, includes a toy system in which both a logic-control signal (*i.e.*, a signal representing a logical, or discrete, value) and an analog sound signal are transmitted to a toy figure, the logic-control signal controlling an actuator within the toy figure and the analog sound signal being coupled to a loudspeaker within the toy figure. The analog signal is generated by a sound subsystem of a multimedia system. The logic-control signal(s) are correlated to the spoken words represented by the analog sound signal using an array stored in a memory of the multimedia system.

Tong fails to disclose the use of a computer to generate a logic-control signal to actuate a toy figure, as recited in Claim 1. Tong only employs an analog signal, which is converted by a rectifier within the toy doll to produce a D.C. signal which is applied to drive motors for the mouth and the eyes of the toy. (Column 2, lines 51-55) Because Tong fails to disclose both an analog sound signal for driving a loudspeaker and a logic-control signal to control a toy figure, Tong cannot anticipate Claim 1.

Furthermore, Tong fails to disclose a memory for storing data representing the logic-control signals and correlated to the spoken words. As previously described, Tong utilizes only a single analog signal that, within the toy figure, is converted by circuitry to derive a D.C. voltage which is used to control the movement of portions (e.g., mouth and eyes) of

the toy figure. (Column 2, lines 28-55). Thus, not only does Tong only employ a single analog signal, but the movement of portions of the toy figure are a function of the analog signal. In contrast, for the invention recited in Claim 1, the movement of an actuator within the toy figure is controlled by logic-control signals that are correlated to the spoken words (represented by the analog sound signal) within an array stored in a memory of the multimedia system. Whereas Tong does not disclose such an array for correlating the movements of the toy figure to the words spoken by the toy figure, Tong cannot anticipate Claim 1.

Anticipation is established only when a single prior art reference discloses each and every element of a claimed invention. Furthermore, anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim. Thus, Tong fails to anticipate Claim 1. Whereas Claims 2, 9 and 12-13 are dependent upon Claim 1, and Claim 1 is not anticipated, Tong cannot anticipate the respective dependent claims. Accordingly, the Applicant respectfully requests that the Examiner withdraw the rejection of Claims 1-2, 9, and 12-13, under 35 U.S.C. 102(e), as being anticipated by Tong.

#### REJECTIONS UNDER 35 U.S.C. §103(a)

Applicant respectfully traverses the rejections, under 35 U.S.C. 103(a), of Claim 11 as being unpatentable over Tong, Claims 3-8, 10, 14, 17-25, and 28 as being unpatentable over Tong in view of Gasper, and Claims 15-16 and 26-27 as being unpatentable over Tong and Gasper, in further view of Noll. For the reasons that follow, the Examiner has failed to establish a *prima facie* case of obviousness of the foregoing claims. Whereas

Claim 11 depends from independent Claim 1, the rejection of Claim 11 will be addressed by showing that Claim 1 is non-obvious. Furthermore, whereas independent Claims 14 and 25 contain certain limitations analogous to those of Claim 1, the arguments made with respect to Claim 1 apply with equal force to Claims 14 and 25, as well as the respective dependent claims.

With respect to Claim 11, Applicant has previously explained that Tong does not disclose every element of Claim 1. Thus, Tong cannot disclose every element of Claim 11, which depends from Claim 1.

The Examiner states with respect to the further limitation to the subject matter of Claim 1 added by Claim 11 that:

"it would have been obvious to one skilled in the art . . . to provide a second dimension to synchronize the second articulating member with the first and thus, the sound. Tong already provides for a second articulating member. Increasing the array dimension with the same binary data to provide movement data to that second member without constructing an independent array would be a simple and efficient method of moving the second member." (Office Action; ¶ 11).

For the reason that Tong does not even provide a memory for storing an array of data representing logic-control signals and correlated to spoken words, as recited in Claim 1, the Examiner's reasoning for finding Claim 11 to be obvious is moot. Nevertheless, applicant traverses any suggestion that increasing the array dimension would be obvious.

Turning now to the rejection of Claims 3-8, 10, 14, 17-25 and 28, under 35 U.S.C. 103(a), as being unpatentable over Tong in view of Gasper, *et al.* (Gasper), are Claims 3-8 and 10 depend from Claim 1 and Claims 17-24 depend from Claim 14. As previously described, Claim 1 as originally presented and as amended requires use of a logic control signal and an array to correlate transmission of the logic-control signal with an analog

sound signal. Claim 14, as originally presented and as amended, contains similar limitations. Tong only employs an analog signal, which is converted by a rectifier within a toy doll to produce a D.C. signal which is applied to drive motors for the mouth and the eyes of the toy. Tong does not disclose a logic-control signal to control a toy figure, nor does Tong disclose a memory for storing an array of data representing logic-control signals correlated to spoken words. Gasper does not disclose use of a logic-control signal to control a toy figure or a memory for storing an array of data representing logic-control signals correlated to spoken words. Thus, the alleged combination cannot meet each and every element in claims depending from Claims 1 or 14. The combination does not establish a *prima facie* rejection.

Furthermore, neither reference provides any suggestion or motivation to combine the references. The Examiner has recognized that "Gasper does not teach employing this system in a physical doll." (Office Action; Section 12). Nevertheless, the Examiner states that it would have been obvious to use Gasper's teachings to "capture a child's attention longer." As this is one of Applicant's stated objectives, and as the Examiner has failed to provide a citation to prior art in support of this stated motivation, it is respectfully submitted that the Examiner's combination of Tong and Gasper to support the rejection appears to be based on impermissible hindsight. "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. . . [o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fritch*, 972 F.2d 1260, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992).

With regard to Claims 25 and 28, Claim 25 includes as a limitation "an actuator situated inside the figure having only two-phases for moving the mouth in a first direction in response to receiving a first logic-control signal representing a first binary data value and in an opposite direction in response to receiving a second logic-control signal representing a second binary data value." As previously described, Tong does not disclose a logic-control signal to control the movements of the toy figure, rather Tong only employs an analog signal, which is converted by a rectifier within a toy doll to produce a D.C. signal which is applied to drive motors for the mouth and the eyes of the toy. Moreover, Tong does not disclose an "actuator . . . having only two-phases." Tong discloses only "[a]ctuators in the form of drive motors." (Column 2, line 37). Gasper, however, also does not disclose a logic-control signal to control a toy figure as recited in Claim 25. Nor does Gasper disclose an "actuator . . . having only two-phases." Indeed, the Examiner has recognized that "Gasper does not teach employing this system in a physical doll." (Office Action; Section 12). Thus, the Examiner has failed to establish a *prima facie* case of obviousness of Claim 25, and Claim 28 which depends therefrom, since the alleged combination does not meet all of the limitations of Claims 25 and 28. Furthermore, as previously asserted, there is no prior art motivation for making the combination.

Finally, the Examiner has rejected Claims 15-16 and 26-27, under 35 U.S.C. 103(a), as being unpatentable over Tong and Gasper as applied to Claims 14-25, and further in view of Noll. Whereas Claims 15-16 and 26-27 are dependent from Claims 14 and 25, respectively, the Applicant will address the rejection with respect to Claims 14 and 25. Because the Applicant has already traversed the Examiner's rejection of Claims 14 and 25,

*supra*, as being unpatentable over Tong and Gasper, the question is merely whether Noll cures the deficiencies of Tong and Gasper.

Noll discloses "an animated doll adapted to reproduce a transcribed voice from a tape recording prepared specially therefor and automatically moving parts of the face in timed relation to the reproduced audible voice . . ." (Abstract) To open and close the mouth of the doll, a "mouth articulating means J is provided to open the mouth by dropping the jaw 24 in response to the intensity of the audio signal emanating from [an] amplifier." (Column 3, lines 59-61; emphasis added). Whereas the amplifier output is coupled to both a speaker and the articulating means J, the audio signal is obviously an analog signal. (Column 3, lines 59-64). In contrast, Claim 25 recites: "an actuator situated inside the figure having only two-phases for moving the mouth in a first direction in response to receiving a first logic-control signal representing a first binary data value and in an opposite direction in response to receiving a second logic-control signal representing a second binary data value." Thus, the control signals for the invention recited in Claim 25 are a function of binary data values, rather than an analog signal as employed by Noll. For this reason, the Examiner has failed to establish a *prima facie* case of obviousness of Claim 25, and Claim 28 which depends therefrom. The Applicant, therefore, respectfully traverses the rejection of Claims 25 and 28 as being unpatentable over Tong in view of Gasper, and further in view of Noll.

The Applicant acknowledges that the Examiner believes that the prior art made of record and not relied upon is pertinent to applicant's disclosure, and that Baer is cited as being closely related to the instant invention. (Office Action; Section 14). The Applicant has reviewed the prior art made of record, including Baer, and does not believe that any

of those references, either individually or in combination, render any of Claims 1-28 unpatentable. The Applicant, however, reserves the right to traverse any formal objection or rejection the Examiner may make based on any of those references.

CONCLUSION

For the foregoing reasons, reconsideration of the application, as amended, pursuant to 37 C.F.R. §1.112 is respectfully requested. It is submitted that the application is in condition for allowance, and such action is respectfully requested.

Should any fee be due in connection with this paper, please charge Deposit Account No. 13-4900 of Munsch Hardt Kopf Harr & Dinan, P.C.

The Examiner is invited to telephone the undersigned attorney at (214) 855-7571 if she has any questions.

Respectfully submitted,

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